



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULLAS GARGI and DANIEL R. TRETTER

Application No. 09/904,627

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 9, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that the appellants filed the Appeal Brief of June 22, 2005 using the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the Appeal Brief filed on June 22, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states in part:

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.
(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a

reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Upon an in-depth review of the Appeal Brief indicates that the following section is missing from the Appeal Brief of June 22, 2005:

"Grounds of rejection to be reviewed on appeal", as set forth in 37 CFR § 41.37(c)(1)(vi).

Also, arguments need to be under the "Arguments" heading and not under the "Summary of the Claimed Subject Matter." In addition, the heading of "Issues" is no longer used and has been replaced by the "Grounds of Rejection to be Reviewed on Appeal."

A substitute brief that is in compliance with § 41.37(c) is required. For more information See United States Patent and Trademark website www.uspto.gov, in particular the web page entitled More Information on the Rules of Practice Before the BPAI, Final rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Further, the Examiner's Answer mailed April 22, 2005 does not comply with 37 CFR § 41.37(c). The "Evidence relied upon" is missing and "Issues" is no longer used. Furthermore, the "Prior Art of Record" has been replaced by the "Evidence relied upon." Correction is required, Accordingly it is

ORDERED that the application is electronically returned to the Examiner to:

- 1) hold the Appeal Brief of June 22, 2005 defective;
- 2) for applicant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for the examiner to consider the substitute Appeal Brief, vacate the Examiner's Answer mailed April 22, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

CRAIG FEINBERG
Program and Resource Administrator
(571) 272-9797

GJH

cc: HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS, CO 80527-2400